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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,916	12/20/2001	Masaya Nagata	1248-0571P-SP	2105
2292	7590	10/20/2005		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER BILGRAMI, ASGHAR H	
			ART UNIT 2143	PAPER NUMBER
DATE MAILED: 10/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,916

Applicant(s)

NAGATA, MASAYA

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05/12/04, 07/21/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 9, 15, 16, 20 & 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al (6,662,225).
3. As per claims 6, 9, 15, 16, 20 & 21 Motoyama disclosed a service management method managing an application program made up of a combination of a plurality of functions by a computer (col.8, lines 18-21), making said computer carry out the steps of: detecting that a specific function is selected or performed (col.12, lines 28 & col.12, lines 35-46); and writing number of detection of said detected function in a management file which records usage conditions of said plurality of the functions (col.12, lines 63-67 & col.13, lines 1-2), wherein the functions are grouped into at least a first level and second level, at least one function in the first level being associated with at least one function in the second level, and the at least one function in the first level is identified as used only if each function in the second level that is associated with the at least one function is detected a predetermined number of times (col.12, lines 6-67). Having functions grouped into different levels and being associated to each other is an inherent part of any software. Also Motoyama discloses monitoring the usage of software, in particular

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“clicking” on a specific command to cause the software program to perform a certain function (col.12, lines 6-34).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al (U.S. 6,662,225) and Horvitz et al (U.S. 6,262,730 B1).

6. As per claims 1, 3, 5, 12, 13, 14, 17 & 18 Motoyama disclosed a service management program for managing a software package made up of a combination of plurality of functions including a function for carrying out processing to transmit/receive information via a network, by a computer (col.8, lines 18-21, col.8, lines 54-67 & col.9, lines 1-21), provided for: receiving usage conditions of the functions of said software package from a device in which said software package is installed via the network (col.12, lines 6-28, col.12, lines 35-46. However Motoyama did not explicitly disclose making said computer carry out processing to transmit a message for

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promoting use of a function which is indicated in the usage conditions as a function used less than a predetermined number of times, to said device.

In the same field of endeavor Horvitz disclosed making said computer carry out processing to transmit a message for promoting use of a function which is indicated in the usage conditions as a function used less than a predetermined number of times, to said device (col.23, lines 61-67 & col.24, lines 1-23).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated promoting use of a function indicated in the usage condition to have be used less than predetermined number of times as taught by Horvitz in the service management program disclosed by Motoyama in order to make the service management system more versatile and robust in term of providing assistance and making it more user friendly.

7. As per claim 2 Motoyama-Horvitz disclosed the service management method as set forth in claim 1, wherein: said predetermined number of times is set as not less than twice (Motoyama, col.3, lines 3-7, col.12, lines 63-67 & col.13, lines 1-2).

8. As per claims 7 & 10 Motoyama-Horvitz disclosed the service management method as set forth in claim 6, further making said computer carry out the step of: displaying data which includes at least either of data on a used function and data on an unused function described in said management file (Horvitz, col.2, lines 64-67 & col.3, lines 1-12), on an activation screen of said application program (col.23, lines 61-67 & col.24, lines 1-23)

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9. As per claims 8 & 11 Motoyama-Horvitz disclosed the service management method as set forth in claim 6, further making said computer carry out the step of transmitting data which includes at least either of data on a used function and data on an unused function described in said management file (Motoyama, col.12, lines 6-28 & col.12, lines 35-46).

Response to Arguments

10. Applicant's arguments filed 07/21/2005 have been fully considered but they are not persuasive.

11. The applicant argued "Horvitz provide contextual help, but does is not designed to promote the use of the function used less than a predetermined number of times as required by claim1."

12. As to applicant arguments Horvitz discloses promoting assistance to the user based on considering multiple pieces of evidence including user activities (usage of functions) that are autonomously sensed by the program. It would have been obvious incorporate a threshold limit to calculate the number of times a function has not been used, there are several rule based models available in prior art that perform a specific task once a predetermined (threshold) is achieved (col.1, lines 49-65).

13. The applicant argued "Neither reference suggests at least the step of receiving content from the service provider related to a function that is used less than a predetermined number of times as now required by claim 3.

14. As to applicants arguments please see Examiner's comments on line 12.

15. The applicant argued claim 5 requires a service management method that includes the step of receiving usage conditions of the functions of the software package over the network and transmitting a message for promoting use of a function to the device on which the software package is installed. Neither reference shows or suggests these steps.

16. As to applicants argument Motoyama disclosed that device communicate with remote monitoring, diagnosis and control station via the network (col.4, lines 56-61). When reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ

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12 (CCPA 1977). As to the arguments relating to promoting the use of a function, please refer to Examiners comments on line 12.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AB

Asghar Bilgrami
Examiner
Art Unit 2143



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